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## FACSIMILE TRANSMISSION

TO	COMPANY/FIRM	RECIPIENT FAX	RECIPIENT PHONE
Examiner Corbett B. Coburn	United States Patent and Trademark Office	571.273.8300	571.273.4447

  

SENDER	DATE	SENDER'S FAX	SENDER'S PHONE
Brian Mack	November 30, 2005	646.728.2896	212.596.9084

  

CLIENT	RE:	TIME	PAGES (INCLUDING COVER)
003043.0037	Application No. 09/827,509 (ODS-37) - Proposed Examiner Interview		2

## MESSAGE

Examiner Coburn:

As per our phone conversation of the other day, we would like to schedule an interview with you regarding Application No. 09/827,509. Attached is a proposed topic for discussion at the interview. As indicated on the attachment, this document is for discussion purposes only and is not for entry into the application. Please feel free to call or email me at [brian.mack@ropesgray.com](mailto:brian.mack@ropesgray.com) if you have any questions.

Sincerely,

Brian E. Mack  
Patent Agent

This communication is intended only for the use of the addressee and may contain information that is privileged and confidential. If you are not the intended recipient, you are hereby notified that the unauthorized dissemination of the communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone. If not completely received, please call back at 212.596.9300 as soon as possible.

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**FOR DISCUSSION PURPOSES ONLY  
NOT FOR ENTRY INTO APPLICATION**

U.S. Patent Application No.: 09/827,509  
Filed: April 5, 2001  
Our Docket: ODS-37

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**Parties:**

USPTO: Examiner Corbett B. Coburn  
Ropes & Gray: James A. Leiz (Reg. No. 46,109) and  
Brian E. Mack (Reg. No. 57,189)

**PROPOSED TOPIC FOR DISCUSSION**

**I. Whether Gordon Shows Proposed Wagers**

The September 13, 2005 Final Office Action maintains that Gordon teaches a method and system for providing what effect a user's proposed wager would have on a parimutuel pool to the user. The reasoning behind this appears in the May 24, 2005 Final Office Action where it is stated that the "[u]nless Applicant can show that Gordon's device will only work after the player has finalized the bet by transferring the money to the bookmaker, Examiner must assume that at the very least Gordon's device has the inherent ability to process proposed bets." (Final Office Action, page 6).

Applicants wish to discuss with the Examiner whether Gordon's device inherently shows proposed wagers in view of the following case law. To sustain a rejection under 35 U.S.C. § 103, "the prior art references must teach or suggest all the claim limitations." Any feature not directly taught or suggested by the references "must be inherently present." MPEP § 706.02 (emphasis added).

Inherency may not be established by possibilities. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). When a reference is silent about an asserted inherent characteristic, evidence that the missing descriptive matter is necessarily present is required. See *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

Applicants believe that proposed wagers are not necessarily present in Gordon at least because (1) Gordon only refers to increasing resistances for wagers that have been actually placed; (2) Gordon's device does not need to be able to process proposed wagers to operate properly; and (3) Gordon's deduction feature may be used either to reset the bridge circuit for a subsequent race or to correct a wager that was incorrectly placed.